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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,247	12/31/2003	Masahiro Yamanaka	SIC-02-009-3	3824
29863	7590	03/23/2005	EXAMINER	
DELAND LAW OFFICE P.O. BOX 69 KLAMATH RIVER, CA 96050-0069			LUONG, VINH	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,247

Applicant(s)

YAMANAKA, MASAHIRO

Examiner

Vinh T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/31/03 & 1/13/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. The preliminary amendment filed on December 31, 2003 has been entered.
2. The drawings were received on December 31, 2003. These drawings are unaccepted by Examiner because of the objection below.
3. The drawings filed on December 31, 2003 are objected to because the sectional views, such as, Figs. 2 and 5, do not show the hatching to indicate the materials of which the parts are made. See 37 CFR 1.84(h)(3).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. *Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended.* The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The information disclosure statement filed January 13, 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the

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content of the information, of *each* patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Applicant states “[T]he relevance of the foreign references should be readily apparent from the drawings.” This general statement does not discuss the relevance of *each* patent listed that is not in the English language as required under 37 CFR 1.98(a)(3). Moreover, the relevance that is apparent from the drawings with respect to the Examiner may not be the same as the relevance that is presently understood by the individual designated in 37 CFR 1.56(c) with the most knowledge about the content of the submitted information in this application. Note that MPEP 609 states:

The concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims. However, see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1376, 54 USPQ2d 1001, 1007 (Fed. Cir. 2000) (“[A]lthough MPEP Section 609A(3) allows the applicant some discretion in the manner in which it phrases its concise explanation, it nowhere authorizes the applicant to intentionally omit altogether key teachings of the reference.”).

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In this case, Applicant does not point out: (a) any particular figure; (b) the similarities between the item of information and the claimed invention; and/or (c) the material teachings of the reference. Applicant is respectfully urged to follow the suggestions in MPEP 2004.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 22-24 and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Burge (USP 4,027,572).

Regarding claim 22, Burge teaches a tool (Fig. 5) for an axle bolt comprising: a tool body 11; a plurality of splines 18 circumferentially disposed on and extending radially outwardly from the tool body 11, and a tool operating member 10 extending radially outwardly from the tool body 11.

Regarding claim 23, the tool operating member 10 has a disk shape.

Regarding claim 24, the tool body 11 extends from a side surface of the tool operating member 10.

Regarding claim 26, the tool operating member 10 includes a gripping rim 10 extending from a side surface thereof.

Regarding claim 27, the gripping rim 10 is disposed at a radially outermost portion of the tool operating member 10.

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Regarding claim 28, the tool body 11 extends from a first side surface of the tool operating member 10, and wherein the gripping rim extends from an opposite second side surface of the tool operating member 10.

7. Claims 22-24 and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagano'149 (EPO 0512149 A1 cited by Applicant).

Regarding claim 22, Nagano'149 teaches a tool 9 (Fig. 3) for an axle bolt 2 comprising: a tool body 12; a plurality of splines 12a circumferentially disposed on and extending radially outwardly from the tool body 12, and a tool operating member 9a extending radially outwardly from the tool body 12.

Regarding claim 23, the tool operating member 9a has a disk shape.

Regarding claim 24, the tool body 12 extends from a side surface of the tool operating member 9a.

Regarding claim 26, the tool operating member 9a includes a gripping rim 9a extending from a side surface thereof. See Attachment.

Regarding claim 27, the gripping rim 9a is disposed at a radially outermost portion of the tool operating member 9a.

Regarding claim 28, the tool body 12 extends from a first side surface of the tool operating member 9a, and wherein the gripping rim 9a extends from an opposite second side surface of the tool operating member 9a.

8. Claims 22-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Kastan et al.'691 (US Patent No. 4,545,691).

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Regarding claim 22, Kastan'691 teaches a tool 38 (Fig. 2) or 64 (Fig. 5) for an axle bolt comprising: a tool body 54, 64; a plurality of splines 56, 82 circumferentially disposed on and extending radially outwardly from the tool body 54, 64, and a tool operating member 90 extending radially outwardly from the tool body 54, 64.

Claim 22 and other claims below are anticipated by Kastan'691 because Kastan'691 teaches each and every positively claimed element. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, note that the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 U.S.P.Q.2d 1429 (CAFC 1997).

Regarding claim 23, the tool operating member 90 has a disk shape.

Regarding claim 24, the tool body 54, 64 extends from a side surface of the tool operating member 90.

Regarding claim 25, the tool operating member 90 includes a knurled outer peripheral surface.

Regarding claim 26, the tool operating member 90 includes a gripping rim 90 extending from a side surface thereof.

Regarding claim 27, the gripping rim 90 is disposed at a radially outermost portion of the tool operating member 90.

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Regarding claim 28, the tool body 54, 64 extends from a first side surface of the tool operating member 90, and wherein the gripping rim 90 extends from an opposite second side surface of the tool operating member 90.

Regarding claim 29, the gripping rim 90 has a knurled outer peripheral surface.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kastan'691.

Kastan'691 teaches the invention substantially as claimed. However, Kastan'691 teaches four splines instead of eight splines (Fig. 5).

It is common knowledge in the art to change Kastan'691's number of splines from four to eight in order to increase the coupling of Kastan'691's tool with the axle 30. The use of eight splines is notoriously well known (see, e.g., eight splines in the tool 7 of US Patent No. 5,852,954 issued to Yamanka). See *Sjolund v. Musland*, 6 USPQ2d 2020, 2026 (CAFC)(the use of a plurality of panels instead of a single panel is obvious).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to change Kastan'691's number of splines from four to eight in order to increase the coupling of Kastan'691's tool with the axle bolt or the like as taught or suggested by common knowledge in the art.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Meggiolan (splines 23), Hermansen et al. (splines 190 in Fig. 1), Lonnqvist et al. (tool 4 in Fig. 3), and Olson et al. (tool 24).

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The Examiner can normally be reached on Monday - Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

March 17, 2005



Vinh T. Luong
Primary Examiner